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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,695	HEUSINKVELD, RIGBY JACOBS	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's amendment of 11/11/05 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, it is not clear as to whether or not the memory is configured to store warranty information corresponding to the consumable or if the memory is actually storing warranty information corresponding to the consumable. This is because at line 6, it is recited "the memory configured to store" and then at line 8 it is recited "warranty information is stored on the memory". This language is contradictory and renders the scope of the claim indefinite.

For claims 3,6,7, the same issue as was addressed in claim 1 is present in these claims. Claim 1 recites that the memory is configured to store computer executable instructions but claim 3 recites "further comprising additional computer executable instructions". Claim 7 also claims "further comprising additional computer executable instructions". Is the memory just configured to store computer instructions or is it actually storing computer instructions?

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,4-6, are rejected under 35 U.S.C. 102(b) as being anticipated by Hirst et al. (5930553).

For claims 1,2, Hirst discloses a consumable item 18 that is used in a printer device 10. The consumable item 18 has a consumable as claimed. Hirst discloses an interface that is capable of allowing (facilitating) communication as claimed. See column 2, lines 37-39 and lines 43-47 where the interface is disclosed. The claimed memory is 19 and is configured to store data as claimed. Claiming that the memory *is configured to store* certain types of data is just a recitation to the ability of the memory to store that kind of data, with the data not actually being claimed as being stored. Hirst discloses that numerous types of data are able to be saved in memory 19 and also discloses that computer instructions (code patch) are able to be stored in memory 19. The memory 19 of Hirst is configured to store the kind of data that applicant has recited. With respect to the added limitation that the information is stored at a time of manufacture of the consumable item, this limitation is not taken to be reciting any further structure to the recited system. At best, this limitation is a product by process limitation; accordingly, only the end structure that the process results in is given patentable weight, not the recited steps. In this case, because the memory is just claimed as being "configured to store" data and it is unclear if the data is actually even stored, the timing

of the storage of the data is not reciting any further structure to the memory itself. The memory 19 of Hirst is configured to allow for data to be stored at any time, whether that is just after manufacture or weeks later.

For claim 4, Hirst discloses a processor. See column 4, lines 39-44 where it is disclosed that the consumable 18 has a sensor that detects toner level and that can send out a low toner signal when such a condition is detected. This method of sensing data and sending out a signal inherently requires a processor. You need a processor to perform these steps. There must also be a processor to allow for the storage of data and for carrying out the computer instructions stored in the consumable memory.

For claim 5, the user can interact with the system as claimed. This can be simply using the host computer to print a text document using the printer that contains the consumable item.

For claim 6, applicant is claiming the kind of information that is stored in the memory (or configured to be stored, see 112 rejection). When applicant is reciting the kind of data that is saved (or configured to be saved in the memory), this does not amount to anything more than a recitation to descriptive data that does not define over the prior art. To claim that the memory is storing (or configured to store) warranty forms or warranty terms is just a recitation to non-functional descriptive material. Patentable weight is not given to purely descriptive material that is stored in memory. Hirst anticipated what is claimed for the reason that Hirst recognizes that warranty data can be stored in memory 19. As stated previously, the timing of when the data is saved does not result in a further recitation to any structure of the memory.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3,7-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. (5930553) in view of Junger et al. (2004/0172260).

For claims 7-10,12,17-19,21,22, Hirst discloses an image forming consumable for printers. The consumable item is 18 and the consumable item has an interface to allow communication with the device (the printer/computer the consumable is used in), see column 2, lines 37-39 and lines 43-47. The memory is 19 (means for storing) and is disclosed as storing the kind of information as claimed. The memory is fully capable of storing any kind of data. The consumable item 18 is disclosed as having computer instructions (means for obtaining) that obtain various types of data that is to be stored on the memory 19. Warranty information such as installation date, and use data such as the number of prints, can be obtained and stored in the memory 19. See column 3, lines 16-33. Hirst discloses that when the consumable item is first installed the version number and/or the manufacturing date are obtained from the consumable item. This requires the data be saved by the manufacturer at a time of manufacture as claimed. Hirst discloses that an Internet connection can be use to transfer usage and statistical data from the memory 19, see column 6, lines 16-20. Not disclosed is the limitation of prompting the user for user provided information or computer executable instructions

that are configured to request additional warranty information from the user. Additionally, for claim 17, the recitation of "at a time of manufacture of the item" with respect to the "means for storing" is just taken to be reciting a means for storing because the timing of the storage has nothing to do with the structure of the article.

Hirst discloses that the consumable can store warranty data and usage data in memory 19. In column 6, lines 16-20 Hirst discloses that with respect to the software of the invention, "*Other modifications include providing an Internet or BBS link to provide an additional or bidirectional communication with an image forming device to transfer code patches, usage and statistical information as well as informing the user of new features*".

Junger discloses an automated warranty system where the user can use the Internet to obtain information about the return of a product *or can use the Internet to initiate a product return.* Junger discloses that by allowing a consumer to use the Internet to initiate a product return, this saves the retailer or manufacturer from having to become involved in the return process and eliminates the need for call centers, provides more efficient handling of the shipping of the product, and overall provides a simplified process of initiating and tracking a product return. The consumer uses a web site that requests some information such as name, address from the consumer initiating a product return. The automated system then uses the user-entered data to check if the product qualifies for a return under the warranty. If the product is qualified for a return under the warranty a return authorization is provided to the consumer and return instructions are also given to the consumer on how to go about returning the product.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Hirst with computer instructions that would link the consumer to a web site where a product return can be initiated as disclosed by Junger (means for interacting and means for completing). Hirst discloses that some of the software stored in the memory 19 of consumable 18 can provide an Internet link for the purposes of data communication for software patches and transfer of usage and statistical data. One of ordinary skill in the art would have found it obvious to provide Hirst with the ability to allow the consumer to initiate a product return in the manner disclosed by Junger so that the advantages of the invention of Junger can be realized (i.e. eliminates the need for call centers, provides more efficient handling of the shipping of the product, and overall provides a simplified process of initiating and tracking a product return).

For claims 3,11,20, not disclosed is the limitation of computer instructions configured to print the completed warranty information and printing the information as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the completed warranty information for the consumer so that the consumer has a hard copy record of the information relating to the product return and has a copy of the instructions that are to be followed for returning the product to the manufacturer. This is similar to the act of providing the consumer a receipt for a returned product and would have been obvious to one of ordinary skill in the art.

For claims 13,23, not disclosed is the running of a diagnostic test as claimed. If the consumer notices that the consumable does not appear to be working properly, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to perform a diagnostic test to determine if the consumable is defective or not. This could simply be the act of attempting to print a test page to see if the printer is working ok or can be the act of running a software diagnostic routine to check the printer and consumable as is well known in the art.

For claims 14,24, not specifically disclosed is the data comparison claimed. When a consumer is using the Internet to initiate a product return, Junger discloses that the data about the product is used to verify if the return is to be accepted or not. The product data is compared to warranty data to be able to make a determination of whether or not the product is to be accepted as a valid return. Because Hirst discloses that the Internet connection can be used to transfer usage data and statistical data, it would have been obvious to one of ordinary skill in the art to compare the diagnostic test data to warranty data to determine if the consumable is defective or not. Part of the determination of whether or not a product is defective is to assess what is wrong with the product (i.e. reason for return) and using diagnostic test data would have been very obvious to one of ordinary skill in the art at the time the invention was made because this is the kind of data that would tell you what was wrong with the consumable.

For claims 15,25, when the user is using the Internet to conduct a product return, the resulting invention results in the use data, user provided information, and warranty information being stored in an external memory as claimed because in Junger the data is being saved so that one can track the return. The data that is communicated over the Internet is saved in memory as claimed.

For claim 16, the replacement consumable is interpreted to be the use of another consumable in the system of Hirst. A second consumable would have the same software for Internet product return initiation as the first one does.

7. Applicant's arguments filed 11/11/05 have been fully considered but they are not persuasive.

With respect to the arguments for claim 1, applicant is arguing that Hirst does not disclose the storing of the same kind of data as claimed. This argument is not commensurate with the scope of the claims because the claims only recite a memory *"configured to store"* and this is not the same as reciting the memory is actually storing the claimed data. The recitation directed to when the data is stored does not amount to a further recitation of any structure. At best, this limitation is a product by process limitation; accordingly, only the end structure that the process results in is given patentable weight, not the recited steps. In this case, because the memory is just claimed as being "configured to store" data and it is unclear if the data is actually even stored due to conflicting claim language, the timing of the storage of the data is not reciting any further structure to the memory itself and is not a patentably distinguishing feature. The memory 19 of Hirst is configured to allow for data to be stored at any time, whether that is just after manufacture or weeks later. Additionally, Hirst does disclose that manufacture date or version number are stored in the consumable item memory and this must have been stored by the manufacturer at a time of manufacture. With respect to the recitation of the memory being configure to store the computer

instructions, Hirst does disclose that the memory 19 stores computer instructions. Hirst is fully capable of storing the claimed type of computer instructions. Again, applicant has not claimed that the instructions are in fact stored in the memory, just that the memory is configured to store the instructions. There is a difference between what the claim recites and what applicant is arguing.

With respect to the traversal of the 103 rejection, applicant has argued that because the claims do not recite the use of the Internet to link to the website, the examiner's combination fails because Junger uses the Internet and links to a website. This is a non-persuasive argument and in the opinion of the examiner, applicant has not addressed the reasoning behind the obviousness rejection itself. What about claim 8 that is reciting the use of the Internet to transmit the warranty data to a warranty issuer? This claim seems to moot applicant's argument because applicant is claiming the use of the Internet, and just because Junger uses the Internet and a website does not mean that the rejection is improper. The argument attacking Junger alone is non-persuasive. Junger does not have to teach consumable items and the storing of data because Junger is not being relied upon for those features. This argument is non-persuasive. The statement that *"neither Hirst or Junger makes any mention of a consumable item installed in a device where the consumable item includes a memory to store warranty information at a time of manufacture of the consumable item"* is respectfully disagreed with, because Hirst discloses what applicant has stated Hirst does not disclose. How can applicant argue that Hirst is not concerned with consumable items and does not have a memory? This is factually incorrect and applicant is encouraged to read Hirst for

what it teaches. The same argument was made for claim 6 and is non-persuasive for the same reason.

Concerning the argument for claim 4, applicant has stated that they do not believe the processor to be inherent, but no reasoning as to why has been presented. The fact that it may be unlikely that a processor is present is not persuasive.

The argument for claim 9 has been fully addressed in the current rejection of record and no further comments are deemed as necessary.

For claim 17, the argument that the prior art does not have a means to store warranty terms is non-persuasive. Hirst discloses a memory 19 that is fully capable of storing any kind of warranty data one wishes to store. As stated previously, the language "configured to" is not the same as reciting that the memory is actually storing the recited kind of data.

The arguments are found non-persuasive.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER